



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/613,491	07/11/2000	Luther C. Abel	C1117-991100	9981

26379 7590 02/09/2005

DLA PIPER RUDNICK GRAY CARY US, LLP
2000 UNIVERSITY AVENUE
E. PALO ALTO, CA 94303-2248

EXAMINER

DASS, HARISH T

ART UNIT	PAPER NUMBER
----------	--------------

3628

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/613,491

Applicant(s)

ABEL ET AL.

Examiner

Harish T Dass

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Applicant's request for reconsideration of the finality of the rejection of the last Office action, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 10, 17, 23, 25-28, and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fleming (US 5,953,710) in view of Joao et al (hereinafter Joao - US 6,529,725).

Re. Claim 1, Fleming discloses an interface (items 60 & 62) between a merchant's bank and a bank at which a consumer has an account for conducting card-based transactions, the interface being remotely accessible by the consumer for selectively restricting approval of a transaction [see entire document particularly, Abstract; Figures 1-11; C1 L5 to C4 L11]. Fleming does not explicitly disclose dynamically restricting (interactively) approval of individual transactions (transaction).

However, Joao discloses a transaction security apparatus and method including an input device for inputting transaction data, a processing device for processing the transaction data and for generating a first signal corresponding to the transaction, and a transmitter for transmitting the first signal over a communication network directly to a communication device associated with an individual account holder and provides notification to the individual account holder of the transaction, accounts, cards, and

dynamically restricting (interactively approval/deny) approval of individual transactions [see entire document particularly, Abstract; Figures 1-2. C3 L66 to C5 L55; C6 L22 to C7 L8; C15 L19 to C18 L29; C20 L16-L28; C35 L60 to C36 L49; C37 L39 to C38 L40; C43 L15 to C44 L22; C44 L23-L30] to notify the account owner of unauthorized transaction(s), using fax, telephone, etc. for performing user interactive control, monitoring, authorization, and notification and transmit a signal (message) to point-of-sale to proceed to complete the transaction or cancel the transaction. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosures of Fleming and Joao and dynamically restricting (interactively) approval of individual transactions to prevent fraud.

Re. Claims 2, Fleming discloses wherein the bank at which the consumer has an account and the interface each determines independently of the other whether to approve the transaction [Figures 1, 3-6; C1 L5-47].

Re. Claims 10, Fleming further discloses telecommunications link [for example figure 1] and for examples URL for MasterCard web site (www.mastercard.com/Info/products.htm) [front page]. Further, Joao discloses wherein the interface comprises a web server for allowing the consumer to access the interface via the World Wide Web [Figure 11 # 450; C11 L49-L55; C12 L58-L62; C35 L45 to C36 L50] to allow customer access the system and communicate with system using personal computer and Internet. Further, online access to banking accounts and credit cards are known. Similarly, Internet is a well known communication tool which uses server to access network and used by clients world wide to transmit email, documents, images, etc. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosures of Fleming and Joao and provide customer an online account access to review the account status, make payments, etc.

Re. Claim 17, Fleming discloses presenting a card to a merchant for a transaction [see claim 1, C7 L37 to C9 L L10], and communicating information relating to the transaction from the merchant to an interface [Fig. 3]. Fleming does not explicitly disclose and determining at the interface whether to approve or deny the transaction based upon a

Art Unit: 3628

criteria selected by the consumer, and when said determining at the interface finds that the transaction is to be approved based upon the criteria selected by the consumer, communicating information relating to the transaction from the interface to a bank at which the consumer has an account, and determining whether to approve or deny the transaction based upon predetermined criteria selected by the bank and communicating results of said determining whether to approve or deny the transaction to the merchant. However, approval of the charge by the banks (financial institutions) are will known base on the credit limit, etc. Additionally, Joao discloses these steps [see entire document particularly, Abstract; Figures 1-2. C3 L66 to C5 L55; C6 L22 to C7 L8; C15 L19 to C18 L29; C20 L16-L28; C35 L60 to C36 L49; C37 L39 to C38 L40; C43 L15 to C44 L22] to notify the customer about charges and obtain authorization from the customer interactively. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosures of Fleming and Joao and dynamically restricting (interactively) approval of individual transactions to prevent fraud.

Re. Claims 23, 25-28 Fleming further discloses presenting a card to a merchant for a transaction [see claim 1, C7 LL37 to C9 L L10], and wherein the presenting is performed by a card user (child) other than the consumer (parent, card account holder), and wherein the bank at which the consumer has the account is selected from a plurality of banks at which the consumer has an account based upon an amount of the transaction, and wherein the bank at which the consumer has the account is selected

Art Unit: 3628

from a plurality of banks at which the consumer has an account based upon a type of goods or services purchased (store issued Master/Visa card) during the transaction, and wherein the bank at which the consumer has the account is selected from a plurality of banks at which the consumer has an account based upon an identity of the merchant, and wherein the bank at which the consumer has the account is selected from a plurality of banks at which the consumer has an account based upon a current account balance [Ref. see claim 1]. Fleming does not explicitly disclose wherein the consumer may dynamically restrict approval of individual transactions through the interface. Joao further discloses wherein the consumer (user) may dynamically restrict approval of individual transactions (transaction) through the interface (terminal) [see entire document particularly, Abstract; Figures 1-2. C3 L66 to C5 L55; C6 L22 to C7 L8; C15 L19 to C18 L29; C20 L16-L28; C35 L60 to C36 L49; C37 L39 to C38 L40; C43 L15 to C44 L22] to allow card owner interactively authorize, deny or restrict a transaction. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosures of Fleming and Joao and add dynamically adjust the limit on-line to eliminate the lag time found in most off-line systems.

Re. Claim 34, Fleming discloses an interface between a merchant's bank and a bank at which a consumer has an account and selectively restricts approval of a transaction for directing card-based transactions made by the consumer [Abstract; Figures 1-11; C1 L5 to C4 L11].

Art Unit: 3628

Fleming does not explicitly disclose directing card-based transactions made by the consumer using any of a plurality of cards to the account wherein the interface selectively restricts approval of a transaction made using one of the plurality of cards in accordance with a limitation on an amount of the transaction, the limitation for each of the plurality of cards not necessarily being equal and the interface being accessible to the consumer for selectively and dynamically (interactively) restricting approval of individual transactions selecting the limitation for each of the plurality of cards. However, Joao discloses these features [Figures 1-2. C3 L66 to C5 L55; C6 L22 to C7 L8; C15 L19 to C16 L65; C17-L1 to C18 L29; C20 L16-L45; C35 L60 to C36 L49; C37 L39 to C38 L40; C43 L15 to C44 L22] to obtain charge authorization from the customer interactively based on the limitations/restrictions placed by cardholder. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosures of Fleming and Joao and dynamically restricting (interactively) approval of individual transactions based on the limitations and/or restriction on particular account.

Re. Claim 36, Fleming discloses an interface between a merchant's bank and a bank at which a consumer has an account and selectively restricts approval of a transaction for directing card-based transactions made by the consumer [Abstract; Figures 1-11; C1 L5 to C4 L11].

Fleming does not explicitly disclose directing card-based transactions made by the consumer using any of a plurality of cards to the account wherein the interface

Art Unit: 3628

selectively restricts approval of a transaction made using one of the plurality of cards based upon whether the consumer has enabled (activation) or disabled (de-activate) the card being used, the interface being accessible to the consumer for selectively and dynamically restricting approval of individual transactions selectively enabling or disabling (de-activate) each of the plurality of cards. However, However, Joao discloses these features [Figures 1-2. C3 L66 to C5 L55; C6 L22 to C7 L8; C15 L19 to C16 L65; C17-L1 to C18 L29; C20 L16-L45; C35 L60 to C36 L49; C37 L39 to C38 L40; C43 L15 to C44 L22] these features [Figures 1-2. C3 L66 to C5 L55; C6 L22 to C7 L8; C15 L19 to C16 L65; C17-L1 to C18 L29; C20 L16-L45; C35 L60 to C36 L49; C37 L39 to C38 L40; C43 L15 to C44 L22] to deactivate a card if stolen. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosures of Fleming and Joao cancel or de-active a card if stolen or reached its limit.

Re. Claims 35 & 37 Fleming further discloses telecommunications link [for example figure 1] and for examples URL for MasterCard web site (www.mastercard.com/Info/products.htm) [front page]. Further, Joao discloses wherein the interface comprises a web server for allowing the consumer to access the interface via the World Wide Web [Figure 11 # 450; C11 L49-L55; C12 L58-L62; C35 L45 to C36 L50] to allow customer access the system and communicate with system using personal computer and Internet. Further, online access to banking accounts and credit cards are known. Similarly, Internet is a well known communication tool which uses server to

Art Unit: 3628

access network and used by clients world wide to transmit email, documents, images, etc. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosures of Fleming and Joao and provide customer an online account access to review the account status, make payments, etc.

Claims 3-9, 18-22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fleming in view Joao as applied to claims 1 & 17 above, and further in view of Oncken et al (US 4,725,719).

Re. Claims 3-9, 18-22, & 24, Neither Fleming nor Joao explicitly discloses wherein a restriction selected by the consumer includes a restriction to a particular merchant, and wherein a restriction selected by the consumer includes a restriction on the amount of the transaction, and wherein a restriction selected by the consumer includes a restriction on a balance accrued for transactions during a period of time, and wherein the period of time is selected from the group consisting of a day, a week and a month, and wherein a restriction selected by the consumer includes a restriction on a type of goods or services purchased, and wherein the transaction is initiated by a card user other than the consumer, wherein the transaction is consummated without the merchant receiving the identity of the consumer. However, Oncken et al discloses these steps [see entire document particularly, Abs; Figures 1-4; C1 L5 to C6 L11] to enable users to select more than one restricted payee. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to combine the disclosures

Art Unit: 3628

of Fleming, Joao and Oncken et al and include control on usage of the card to use the card for restricted purpose and avoid abuse, prevent fraud and misuse and limit unauthorized use of the card.

Claims 11-16 and 29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fleming (US 5,953,710) in view of Joao and Tsiounis et al (hereinafter Tsiounis - US PG PUB 2001/0039535 A1).

Re. Claim 11, Fleming discloses an interface between a merchant's bank and a bank at which a consumer has an account for conducting card-based transactions and remote accessibility [Ref. see claim 1]. Joao further discloses customer accessing the system using Personal computer, Internet to access his/her accounts [Figure 11 # 450; C11 L49-L55; C12 L58-L62; C35 L45 to C36 L50]. Neither Fleming nor Joao does not explicitly discloses remotely accessible by the consumer for selectively directing individual transactions (transaction) to an account wherein the account to which the transactions are directed is identified from among a plurality of accounts held by the consumer based upon criteria selected by the consumer. However, Tsiounis discloses this step [Abstract; page 5 paragraph 0062 and page 7 paragraph 0075] to allow customer's charge be split between accounts. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosures of Fleming, Joao and Tsiounis to create payment authentication where the trusted component pays the merchant on behalf of the customer.

Re. Claims 12-15, Fleming further discloses wherein the account is identified based upon an amount of the transaction, and wherein the account is identified based upon a type of goods or services purchased, and wherein the account is identified based upon an identity of the merchant, and wherein the account is identified based upon a current account balance [see claim 1 and Figure 2A; C7 L4-L37].

Re. Claim 16, Fleming further discloses telecommunications link [for example figure 1] and for examples URL for MasterCard web site (www.mastercard.com/Info/products.htm) [front page], and Joao further discloses wherein the interface comprises a web server for allowing the consumer to access the interface via the World Wide Web [Figure 11 # 450; C11 L49-L55; C12 L58-L62; C35 L45 to C36 L50] to allow customer access the system and communicate with system using personal computer and Internet. Further, online access to banking accounts and credit cards are known. Similarly, Internet is a well known communication tool which uses server to access network and used by clients world wide to transmit email, documents, images, etc. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosures of Fleming, Joao and Tsiounis to provide customer an online account access to review the account status, make payments, etc.

Art Unit: 3628

Re. Claim 29, Fleming discloses presenting a card to a merchant for a transaction, communicating information relating to the transaction from the merchant to an interface, and communicating results of said determining whether to approve or deny the transaction to the merchant [see entire document particularly, Abstract; Figures 1-11; C1 L5 to C4 L11], and communicating information relating to the transaction from the interface to a bank at which the consumer has the identified account [Fig. 3].

Fleming does not explicitly disclose identifying at the interface an account from among a plurality of accounts held by the consumer to which the transaction is to be directed based upon criteria selected by the consumer, and determining whether to approve or deny the transaction based upon predetermined criteria selected by the bank.

However, Joao discloses determining whether to approve or deny the transaction based upon predetermined criteria selected by the bank [Abstract; Figures 1-2. C3 L66 to C5 L55; C6 L22 to C7 L8; C15 L19 to C18 L29; C20 L16-L28; C35 L60 to C36 L49; C37 L39 to C38 L40; C43 L15 to C44 L22] to notify the customer about charges and obtain authorization from the customer interactively. Additionally, Tsiounis discloses identifying at the interface an account from among a plurality of accounts held by the consumer to which the transaction is to be directed based upon criteria selected by the consumer [Abstract; page 5 paragraph 0062 and page 7 paragraph 0075] to determine whether payment with the payment tender type has been preauthorized. It would have been obvious at the time the invention was made to a person having ordinary skill in the

Art Unit: 3628

art to combine the disclosures of Fleming, Joao and Tsiounis to approve or deny a transaction based on customer authorization/preauthorization.

Re. Claims 30-33, Fleming further discloses wherein the bank at which the consumer has the account is selected from a plurality of banks at which the consumer has an account based upon an amount of the transaction, and wherein the bank at which the consumer has the account is selected from a plurality of banks at which the consumer has an account based upon a type of goods or services purchased during the transaction, and wherein the bank at which the consumer has the account is selected from a plurality of banks at which the consumer has an account based upon an identity of the merchant, and wherein the bank at which the consumer has the account is selected from a plurality of banks at which the consumer has an account based upon a current account balance [Ref. see claim 1].

Response to Arguments

3. Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument, stated in page 3 lines 18-20 the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the

Art Unit: 3628

test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument, stated in page 5 line 1, "Receiving a pseudo-account number ...", there is no such a limitation in the claims. Examiner exams clearly claimed limitations. US Pat. 5,884,271 (Pitroda) discloses a universal electronic card capable of serving a number of different credit cards, bank cards, account management, paying bills, selecting one of many such cards for use in a particular transaction, select one service institution from a group, and etc.

General comments - online shopping allows individual to present any card number to any merchant selectively base on his/her choosing and many commercially available software allows scheduling payments from a particular accounts.

Conclusion

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3628

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR ' 1.111 (c) to consider the references fully when responding to this action.

US Pat. 5,884,271 to Pitroda, March 16, 1999 "Device, system and methods of conducting paperless transactions" discloses a universal electronic card capable of serving a number of different credit cards, bank cards, account management, paying bills, selecting one of many such cards for use in a particular transaction, select one service institution from a group, and etc.

US 6,111,522 to Hiltz et al, Aug. 29, 2000 "Multiple electronic purse parking meter" discloses electronic parking devices (EPD) and in particular with an electronic parking meter that accepts a multitude of forms of electronic payment and split payment.

US 6,658,568 to Ginter et al, Dec. 2, 2003 "Transaction processing system for electronic commerce and transaction management, has rule set with rule-based specification and selection of clearinghouse, and user restrictions on use of identification information" discloses an electronic commerce and rights and transaction management over an electronic network e.g. Internet and/or over organizational internal Intranets and in-home network of electronic appliance and payment disaggregation or split payments at a variety of different destinations and using a variety of different payment mechanisms.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T Dass whose telephone number is 703-305-4694. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S Sough can be reached on 703-308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harish T Dass
Examiner
Art Unit 3628

Harish T Dass

12/24/04